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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) ARC920000132US1	
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on <u>JANUARY 23, 2006</u>		First Named Inventor Barton A. SMITH	
Signature <u>Jeffrey N. Giunta</u>		Art Unit 2677	Examiner Kimnhung T. Nguyen
Typed or printed name <u>JEFFREY N. GIUNTA</u>			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature <u>Jeffrey N. Giunta</u>	
<input type="checkbox"/> applicant/inventor.		Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)		(561) 989-9811	
<input checked="" type="checkbox"/> attorney or agent of record. 42,583 Registration number		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34		January 23, 2006	
		Date	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/845,552 Confirmation No. 3403
Applicant : Barton A SMITH et al.
Filed : April 30, 2001
TC/A.U. : 2677
Examiner : Kimnhung T. NGUYEN
Docket No. : ARC920000132US1
Customer No. : 23334

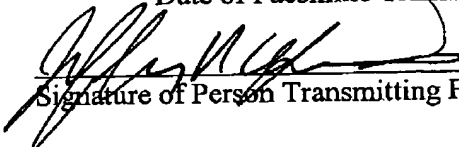
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are submitted with the Applicant's notice of appeal. Independent claim 25 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Holehan (U. S. Patent Number 6,043,809). The Appellant is contesting the rejection of independent claim 25 of the subject application because Holehan clearly does not teach, as required by 35 U.S.C. § 102¹, the elements of independent claim 25 that are discussed below.

The Holehan reference teaches using "scroll bar sensors" that are disposed in proximity to a keyboard contained within a case to which the scroll bar sensors are disposed. Holehan, column 3, lines 36-55 and FIGs 1 and 2. A user can touch the scroll bar sensors to cause the display to scroll in a dimension associated with the scroll bar

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

sensor being touched. Holehan, column 4, lines 20-40. The teachings of Holehan are limited to using "scroll bar sensors" that each has an assigned dimension – either vertical or horizontal. In other words, in order to scroll in a vertical, or up/down, dimension, the user is required to use the "up/down scroll bar sensor 122-124." Holehan, column 4, lines 22-31. Similarly, in order to scroll in a horizontal, or left/right, dimension, the user is required to use the "left/right scroll bar sensor 126." Holehan, column 4, lines 31-35. The user selects a "selected dimension" in the Holehan reference by choosing one of multiple "scroll bar sensors" to provide scrolling input.

Holehan does not teach "A Dimension Selection Switch" as set forth in claim 25

Claim 25 includes a limitation specifying "a dimension selection switch able to select one of at least two dimensions." As a teaching of this limitation, the Examiner cites "scrolling." Office Action dated November 23, 2005, page 2, last paragraph (citing Holehan, column 3, lines 45-46). The Examiner cites a portion of Holehan that states "up and down scroll bar sensors 122, 124 are disposed around edges 134 so that portions of the scroll bar sensors" *Id.*, citing Holehan, column 3, lines 45-46. As for an "ability to select one of at least two dimensions," the Examiner cites "the operator's finger" and the abstract of Holehan. Office Action dated November 23, 2005, page 2, last paragraph. The only relevant portion of the Holehan abstract appears to be portions describing scrolling through a document displayed on a computer's display by using "one or more scroll bar sensors for scrolling up and down and left and right in a document displayed on the computer's display." Holehan, Abstract. The Abstract further states that these scroll bar sensors determine "the location of the operator's finger on the scroll bar sensor." *Id.*

The Appellant asserts that these the cited teachings are clearly not a teaching of "a dimension selection switch" as is set forth by currently pending independent claim 25. In fact, neither the Holehan reference nor any of the cited prior art references, taken either alone or in combination with one another, teaches or suggest such a "dimension selection switch." The Holehan reference is limited to having separate scroll bar

sensors to sense user scrolling input for each dimension. Holehan teaches "Scroll bar sensors 122 and 124 comprise up and down scroll bar sensors Scroll bar sensor 126 preferably comprises a left and right scroll bar sensor." Holehan, column 3, lines 42-49 (emphasis added, referring to elements illustrated in FIG. 1).

The Appellant asserts that the Examiner's apparent argument that "the operator's finger" selecting one of different scroll bar sensors is a teaching of the "dimension selection switch" as set forth in claim 25 is clearly improper and not supportable. The Appellant further asserts that this lack of a proper teaching is even clearer when considering the "dimension selection switch" in the context of other claim limitations, as is discussed below.

Holehan does not teach "A User Input Detector" as set forth in claim 25

Claim 25 further includes a limitation specifying "a user input detector, electrically coupled to the touchpad and the dimension selection switch, for detecting user input from the touchpad and a selected dimension selected by the dimension selection switch and transmitting input signals, wherein the input signals controls movement in the selected dimension in response to the user input."

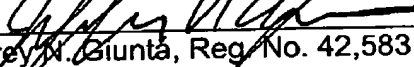
As discussed above, the Holehan reference does not teach or suggest a dimension selection switch as set forth for claim 25. Dimensions are selected in the Holehan reference by using different "scroll bar sensors." The touch pad sensors of Holehan may be analogized to the "touchpad" set forth in the first limitation of independent claim 25, which is clearly separate from the "dimension selection switch" and the "user input detector" limitations. The Appellant asserts that this lack of a teaching is even clearer in the context of this limitation. The Holehan reference clearly does not include a teaching of a user input detector that detects a selected dimension that is selected by the dimension selection switch, as is set forth by this limitation. The Examiner cites a portion of the Holehan reference that describes two sets of conductive traces connecting capacitive elements and that the "conductive traces usually run in

orthogonal directions." Office Action dated November 23, 2005, page 2, last paragraph (citing Holehan, column 4, lines 4-7). The Examiner also cites the Abstract as a teaching of portions of this limitation. *Id.* The Appellant fails to see how these portions of the Holehan reference teach "a user input detector" that is "electrically coupled to ... the dimension selection switch" and that detects "a selected dimension selected by the dimension selection switch" as is set forth for independent claim 25.

Accordingly, independent claim 25 distinguishes over Holehan for at least these reasons and the Examiner's rejection should be withdrawn. The remaining rejected claims depend from claim 25 and accordingly distinguish over Holehan for the same reasons.

Respectfully submitted,

Date: January 23, 2006

By: 
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